



19-114-05

Atty. Dkt. No. 035451-0180 (3728.Palm)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant: Lee et al.

Title: DISPLAY EXPANSION
METHOD AND APPARATUS

Appl. No.: 10/085,911

Filing Date: 2/28/2002

Examiner: Abdulselam, Abbas

Art Unit: 2674

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Sir:

Transmitted herewith are the following documents for the above-identified application.

Brief On Appeal (31 pages).

Check for \$620.00 for Appeal Fee and one-month extension of time. The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447.

Respectfully submitted,

Date 12/13/2005

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BRIEF ON APPEAL

Mail Stop **APPEAL BRIEF - PATENTS**
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Sir:

Under the provisions of 37 C.F.R. § 41.37, this Appeal Brief is being filed together with a check in the amount of \$620.00 (\$500.00 covering the 37 C.F.R. 41.20(b)(2) appeal fee and \$120.00 covering the 37 C.F.R. § 1.136(a) one-month extension of time fee). If this fee is deemed to be insufficient, authorization is hereby given to charge any deficiency (or credit any balance) to the undersigned deposit account 06-1447.

This paper is being filed in response to the final Office Action dated May 17, 2005 (finally rejecting claims 1-29). The Notice of Appeal was filed on September 15, 2005. Appellants respectfully request favorable reconsideration of the application.

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02 FC:1251 120.00 OP

1. REAL PARTY IN INTEREST

The real party in interest is the assignee of record, Palm, Inc. (as recorded in the records of the United States Patent and Trademark Office at Reel/Frame 012657/0268 on February 28, 2002).

2. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences that will directly affect, be directly affected by, or have a bearing on the present appeal, that are known to Appellants or Appellants' patent representative.

3. STATUS OF CLAIMS

This is an appeal from the final Office Action dated May 17, 2005, finally rejecting claims 1-29. Claims 1-29 are on appeal.

4. STATUS OF AMENDMENTS

Claims 1-29 were pending in the application when a final Office Action dated May 17, 2005 was issued. No claims have been amended in the present application subsequent to the receipt of the final Office Action dated May 17, 2005.

5. SUMMARY OF CLAIMED SUBJECT MATTER

The present application relates generally to a handheld computing device (110) having an expandable display (130). The present application also relates generally to a method (800) of using a handheld computer (110) to display greater amounts of user information. The present application further relates to an expandable display (130) for a portable electronic device that is able to reformat information based upon the size of the display surface exposed to the user. Further still, the present application relates to a handheld computer (110) that can automatically determine the size of an expandable display (130). See Specification, page 3, paragraph [0008].

Independent claim 1 relates to a portable electronic device (110) (See, e.g., Specification, pages 5, paragraph [0019]). The portable electronic device (110) includes a housing (See, e.g., Specification, pages 5-8, paragraphs [0021]-[0027] and Figs. 1-2). The

portable electronic device (110) also includes computing electronics (120) supported by the housing (See, e.g., Specification, page 5, paragraph [0020] and Figs. 1-3). The computing electronics (120) include a processor (122), a display controller (123) coupled to the processor (122), and memory (124) coupled to the processor (See, e.g., Specification, pages 9-10, paragraphs [0031]-[0033] and Fig. 3). The portable electronic device (110) also includes an expandable display (130) (See, e.g., Specification, pages 5-8, paragraphs [0021]-[0027]) coupled to the display controller (123). The expandable display (130) is expandable from a first size to a second size (See, e.g., Specification, pages 5-8, paragraphs [0021]-[0027] and Figs. 1-2). The first size is different than the second size (See, e.g., Specification, pages 5-8, paragraphs [0021]-[0027] and Figs. 1-2). The display is viewable by a user in both the first size and second size configurations (See, e.g., Specification, pages 5-8, paragraphs [0021]-[0027] and Figs. 1-2). The portable electronic device (110) further includes a sensor (144, 145) coupled to the processor (122) (See, e.g., Specification, page 8, paragraph [0028]). The sensor is configured to provide a signal representative of the size of the display (See, e.g., Specification, pages 8-9, paragraphs [0028]-[0029]).

Independent claim 14 relates to a method (800) of providing information to a user of an electronic device (See, e.g., Specification, page 12, paragraph [0040]). The method (800) includes providing a first amount of user information on a display in a first size configuration (810) (See, e.g., Specification, page 8, paragraph [0040]). The method (800) also includes physically resizing the display to a second size configuration (820) (See, e.g., Specification, page 8, paragraph [0040]). The method also includes sensing, automatically, the second size configuration of the display (830) (See, e.g., Specification, page 8, paragraph [0040]). The method further includes reformatting the displayed image according to the second size configuration (840) (See, e.g., Specification, page 8, paragraph [0040]).

Independent claim 18 relates to a display (130) for an electronic device (See, e.g., Specification, pages 5-8, paragraphs [0021]-[0027]). The display (130) includes a first display surface visible in a first configuration (See, e.g., Specification, pages 5-8, paragraphs [0021]-[0027] and Figs. 1-2). The display (130) also includes a second display surface visible in a second configuration (See, e.g., Specification, pages 5-8, paragraphs [0021]-[0027] and Figs. 1-2). The display (130) also includes a sensor (144, 145) configured to provide a

configuration signal representative of the display (130) being in one of the first configuration and the second configuration when the configuration is physically changed from the first configuration to the second configuration (See, e.g., Specification, pages 8-9, paragraphs [0028]-[0029]).

Independent claim 26 relates to a portable electronic device (110) configured to provide information to a user of the portable electronic device (110). The portable electronic device (110) includes a means for providing a first amount of user information on a display (130) in a first size configuration (See, e.g., Specification, pages 9-10, paragraphs [0031]-[0033] and Fig. 3). The portable electronic device (110) also includes a means for physically resizing the display (130) to a second size configuration (See, e.g., Specification, pages 5-8, paragraphs [0021]-[0027] and Figs. 1-2). The portable electronic device (110) further includes a means for sensing, automatically, the second size configuration of the display (130) (See, e.g., Specification, pages 8-9, paragraphs [0028]-[0029]). The portable electronic device further includes a means for reformatting the displayed image according to a second size configuration (See, e.g., Specification, pages 9-10, paragraphs [0031]-[0033] and Fig. 3).

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The issues on appeal are (1) whether the Examiner erred in rejecting claims 1, 6, and 18-19 under 35 U.S.C § 103(a) as being unpatentable over U.S. Patent No. 6,262,785 (Kim) in view of U.S. Patent No. 6,567,101 (Kung) and further in view of U.S. Patent No. 6,047,196 (Mäkelä et al.); (2) whether the Examiner erred in rejecting claims 7-8 and 20 under 35 U.S.C § 103(a) as being unpatentable over Kim in view of Kung and further in view of Mäkelä et al. and further in view of U.S. Patent No. 4,171,585 (Macuka); (3) whether the Examiner erred in rejecting claims 2-5, 14-17, and 26-29 under 35 U.S.C § 103(a) as being unpatentable over Kim in view of Kung and further in view of Mäkelä et al. and further in view of U.S. Patent No. 6,570,583 (Kung et al.); and (4) whether the Examiner erred in rejecting claims 9-13 and 21-25 under 35 U.S.C § 103(a) as being unpatentable over Kim in view of Kung and further in view of Mäkelä et al. and further in view of U.S. Patent No. 6,104,379 (Petrich et al.).

7. **ARGUMENT**

I. LEGAL STANDARDS

Claims 1-29 have been rejected under 35 U.S.C. § 103(a), which states:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The legal standards under 35 U.S.C. § 103(a) are well-settled. Obviousness under 35 U.S.C. § 103(a) involves four factual inquiries: 1) the scope and content of the prior art; 2) the differences between the claims and the prior art; 3) the level of ordinary skill in the pertinent art; and 4) secondary considerations, if any, of nonobviousness. Litton Systems, Inc. v. Honeywell, Inc., 87 F.3d 1559, 1567, 39 U.S.P.Q.2d 1321, 1325 (Fed. Cir. 1996); see also Graham v. John Deere Co., 383 U.S. 1, 148 U.S.P.Q. 459 (1966).

In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. In re Piasecki, 745 F.2d 1468, 1471-72, 223 U.S.P.Q. 785, 787-88 (Fed. Cir. 1984). “[The Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” In re Fritch, 972 F.2d 1260, 1265, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992).

As noted by the Federal Circuit, the “factual inquiry whether to combine references must be thorough and searching.” McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 60 U.S.P.Q.2d 1001 (Fed. Cir. 2001). Further, it “must be based on objective evidence of record.” In re Lee, 277 F.3d 1338, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). The teaching or suggestion to make the claimed combination must be found in the prior art, and not in the applicant’s disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art

also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). "It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to '[use] that which the inventor taught against its teacher.'" Lee (citing W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 312-13 (Fed. Cir. 1983)).

II. REJECTION OF CLAIMS 1, 6, AND 18-19 UNDER 35 U.S.C. § 103(a)

In the Office Action dated May 17, 2005, the Examiner rejected claims 1, 6, and 18-19 under 35 U.S.C. § 103(a) as being unpatentable over Kim in view of Kung and further in view of Mäkelä et al.

Claim 1 is in independent form and claim 6 depends from claim 1.

Claim 18 is in independent form and claim 19 depends from claim 18.

For the reasons stated below, Appellants submit that the Examiner's rejection of claims 1, 6, and 18-19 is improper and should be reversed.

A. The Examiner's Rejection of Claims 1, 6, and 18-19 Should Be Reversed Because There is No Suggestion to Combine the Teachings of Kim and Kung and Mäkelä et al.

To establish a *prima facie* case of obviousness based on a combination of prior art references under 35 U.S.C. § 103(a), the Examiner must first show that there is a suggestion or motivation to combine the teachings of those references. This may come in the form of some objective teaching in the prior art or, alternatively, knowledge generally available to one of ordinary skill in the art at the time of the invention that would lead that individual to combine the relevant teachings of the references.

When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the Examiner to explain why the combination of teachings is proper. Ex parte Skinner, 2 U.S.P.Q.2d 1788 (Bd. Pat. App. & Inter. 1986). In this case, the Examiner has not shown – and indeed, cannot show – that there would have been any

motivation or suggestion to one of skill in the art to combine the teachings of Kim, Kung, and Mäkelä et al.

In making the rejection of claims 1 and 18 in the final Office Action dated May 17, 2005, the Examiner acknowledged that “Kim does not teach a sensor coupled to the processor such that the sensor is configured to provide a signal representative of the size of the display.” The Examiner indicated that:

Kung teaches as illustrated in FIG. 9A, the arrowhead F representing a point at which control pen (120) presses the sensing plate 102. Kung discloses as illustrated in FIG. 9B, when a light pressure is exerted on the sensing plate (102) by the control pen (120), the image at the touch point (122) is zoomed in and is displayed inside a small variable display frame (182) that is expanded from the touch point 122. Kung further indicates as illustrated in FIG 9C, when a greater pressure is exerted on the sensing plate (102) by the control pen (120), the image at the touch point (122) is zoomed in and displayed inside a larger variable display frame (182) that is expanded from the touch point (122).

The Examiner concluded:

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kim’s portable display device to adapt Kung’s sensation of expansion of the display screen. One would have been motivated in view of the suggestion in Kung that the sensing plate (102) is functionally equivalent to the desired sensor. The use of a sensing plate helps detect the expansion of the display screen as taught by Kung.

It is unclear exactly where in Kung the Examiner has found this asserted motivation. The Examiner has not pointed to any location within Kung suggesting that the sensing plate (102) is functionally equivalent to the sensor recited in claim 1 or 18. The sensing plate in Kung is disclosed only as being used to initiate expansion of a portion of an image inside a variable display frame displayed on a display panel. In contrast, the sensor recited in claim 1 is “configured to provide a signal representative of the size of the display,” and not a portion of an image inside a variable display frame displayed on the display panel. Similarly, the

sensor recited in claims 18 is “configured to provide a configuration signal representative of the display being in one of the first configuration and the second configuration when the configuration is physically changed from the first configuration to the second configuration,” and not a portion of an image inside a variable display frame displayed on the display panel. There is simply no indication whatsoever in Kung that the sensing plate (102) is functionally equivalent to the sensor recited in claim 1 or 18.

It is also unclear how the Examiner’s statements provide a motivation to combine the teachings of Kung with those of Kim. For example, the Examiner’s statement that “[t]he use of a sensing plate helps detect the expansion of the display screen as taught by Kung” merely asserts that an advantage described in Kung (i.e., sensing expansion of a portion of an image inside a variable display frame displayed on the display panel as described in Kung) may be obtained if Kim is modified to include a component of Kung (i.e., the sensing plate of Kung). However, the Examiner has not provided any indication (nor do either Kim or Kung teach or suggest) how the teachings of Kim would have to be modified to include the teachings of Kung to achieve such an advantage or how the sensing plate of Kung would work with the device taught by Kim. Further, there is no teaching or suggestion in Kim or Kung that their teachings are compatible with each other.

Moreover, there is no showing that such a combination of Kim and Kung would be desirable. For example, even if the sensing plate of Kung was somehow disclosed in Kung as being the functional equivalent of the sensor recited in claim 1 or 18 (which it is not), the Examiner’s statement would at best be an assertion of a corresponding element to that of claim 1 or 18 with no teaching or suggestion of the desirability of combining the teachings of Kung with Kim to somehow arrive at the subject matter of claim 1 or 18. Appellants reiterate that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Instead of showing how the references teach or suggest that such combination would be desirable, the Examiner has taken random elements from otherwise unrelated references to reach a conclusion of obviousness.

Furthermore, the nature of the problem to be solved by the expandable display taught by Appellants' specification was the small size of display screens for portable electronic devices. As such, claims 1 and 18 are directed to a display expandable from a first size to a second size and having a sensor configured to provide a signal representative of the size of the expandable display. In contrast, the sensing plate disclosed in Kung is used to generate a position signal indicating a portion of the image to be expanded inside a variable display frame displayed on a display panel, and has nothing to do with overcoming the small size of the display panel itself. Given the nature of the problem to be solved, one of ordinary skill in the art would find no advantage in Kung's variable display frame or sensing plate for indicating a portion of an image to be magnified inside the variable display frame. Moreover, one of ordinary skill in the art upon reviewing Kim and Kung would not have been motivated to combine Kim and Kung to solve the problem with a display expandable from a first size to a second size and having a sensor configured to provide a signal representative of the size of the expandable display. Rather, one of ordinary skill in the art would have merely achieved a device with a display panel having a single size and using the position signal indicating a portion of the image to be expanded inside a variable display frame displayed on a display panel without overcoming the small size of the display panel itself.

As to Mäkelä et al. the Examiner indicated in the final Office Action dated May 17, 2005 that “[a]s shown on Fig. 5, Makela illustrates a display (9) on folded position, and a larger display (12) on unfolded position.” The Examiner concluded that:

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kim's portable display device to adapt Makela's displayable feature on folded and unfolded positions. One would have been motivated in view of the suggestion in Makela displaying on folded (9) and unfolded position (12) as illustrated on Fig. 5 equivalently yields the desired “viewable display on both the first and second size configurations.” The use of display on folded and unfolded positions helps function a portable communication device with two modes of operation as taught by Makela.

As with the Examiner's statements regarding the asserted motivation to combine Kim and Kung, it is also unclear how the Examiner's statements provide a motivation to combine

the teachings of Mäkelä et al. with those of Kim. For example, the Examiner's statement that “[t]he use of display on folded and unfolded positions helps function a portable communication device with two modes of operation as taught by Makela” merely asserts that an advantage described in Mäkelä et al. (i.e., two modes of operation as described in Mäkelä et al.) may be obtained if Kim is modified to include a component of Mäkelä et al. (i.e., the use of a display in folded and unfolded positions of Mäkelä et al.). However, the Examiner has not provided any indication (nor do either Kim or Mäkelä et al. teach or suggest) how the teachings of Kim would have to be modified to include the teachings of Mäkelä et al. to achieve such an advantage, or how the use of a display in folded and unfolded positions of Mäkelä et al. would work with the device taught by Kim. Further, there is no teaching or suggestion in Kim or Mäkelä et al. that their teachings are compatible with each other.

Moreover, there is no showing that such a combination of Kim and Mäkelä et al. would be desirable. The Examiner's statement is at best an assertion of a corresponding element to that of claim 1 or 18 with no teaching or suggestion of the desirability of combining the teachings of Mäkelä et al. with Kim to somehow arrive at the subject matter of claim 1 or 18. Appellants reiterate that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Instead of showing how the references teach or suggest that such combination would be desirable, the Examiner has taken random elements from otherwise unrelated references to reach a conclusion of obviousness.

As such, the Examiner's statements regarding the motivation to combine Kim, Kung, and Mäkelä et al. do not evince the “thorough and searching inquiry” required by the U.S. Court of Appeals for the Federal Circuit. See McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 60 U.S.P.Q.2d 1001 (Fed. Cir. 2001). Instead of describing a motivation to combine the teachings of Kim, Kung, and Mäkelä et al., the Examiner's statements indicate that the Examiner has engaged in hindsight reasoning to combine such teachings. Here, the Examiner has used Appellants' patent application as a road map to make such a combination. The hindsight reconstruction engaged in by the Examiner is improper where there is no showing that it is based on knowledge that was within the level of ordinary skill in the art at the time

the claimed invention was made and includes knowledge gleaned only from Appellants' disclosure. See M.P.E.P § 2145, Section X, Subsection A.

The rejection of claims 1 and claim 6 (which depends from claim 1) and the rejection of claim 18 and claim 19 (which depends from claim 18) should be reversed because there is no suggestion or motivation to combine the teachings of Kim and Kung and Mäkelä et al. to arrive at the subject matter of these claims.

B. The Examiner's Rejection of Claims 1, 6, and 18-19 Should Be Reversed Because the Combination of Kim, Kung, and Mäkelä et al. Does Not Teach or Suggest At Least One Element of Each of Claims 1, 6, and 18-19

To establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). Even if Kim, Kung, and Mäkelä et al. could be properly combined, these references do not teach or suggest at least one element of each of claims 1, 6, and 18-19. Accordingly, the rejection of claims 1, 6, and 18-19 under 35 U.S.C § 103(a) is improper and should be reversed.

1. The Combination of Kim, Kung, and Mäkelä et al. Does Not Teach or Suggest At Least One Element of Each of Claims 1 and 6

Claim 1 recites "a sensor coupled to the processor, the sensor configured to provide a signal representative of the size of the display." The cited combination of Kim in view of Kung and further in view of Mäkelä et al. does not teach, disclose, or suggest "a sensor coupled to the processor, the sensor configured to provide a signal representative of the size of the display" as included in the combination of elements of claim 1.

The Examiner has acknowledged that "Kim does not teach a sensor coupled to the processor such that the sensor is configured to provide a signal representative of the size of the display." However, the Examiner stated in response to Appellants' arguments filed December 21, 2004 that "Kung teaches positional sensors detecting changes in the orientation of the digital information appliance with respect to the surrounding environment," and maintained the assertion that "[o]ne would have been motivated in view of the suggestion in Kung that the sensing plate (102) is functionally equivalent to the desired sensor" because it

“helps detect the expansion of the display screen as taught by Kung.” Kung, however, discloses only that “[t]he touch screen comprises a display panel 104, a sensing plate 102, a display control 106, and a pressure detector 108,” that “[t]he display panel 104 is used to display the image,” and that “[t]he display control 106 controls the image as shown on the display panel 104, and zooms in on a portion of the image according to the position signal generated by the touch sensor.” (See Column 2, lines 50-65). The sensing plate 102 is used to generate a position signal indicating a portion of the image to be expanded inside a variable display frame, and has nothing to do with the size of the display panel 104 itself. In contrast, the sensor of claim 1 is for sensing the expansion of an expandable display from a first size to a second size, rather than sensing a portion of displayed information, such as an image, to be expanded within a display. Accordingly, Kung fails to disclose “a sensor coupled to the processor, the sensor configured to provide a signal representative of the size of the display” as included in the combination of elements of claim 1. As to Mäkelä et al., it also fails to disclose “a sensor coupled to the processor, the sensor configured to provide a signal representative of the size of the display” as included in the combination of elements of claim 1. Thus, the combination of Kim, Kung, and Mäkelä et al. does not teach, disclose, or suggest “a sensor coupled to the processor, the sensor configured to provide a signal representative of the size of the display,” and particularly not as part of a “portable electronic device” when combined with the other elements of claim 1.

The rejection of claim 1 and claim 6 (which depends from claim 1) should be reversed because the combination of Kim, Kung, and Mäkelä et al. does not teach or suggest at least one element of each of claims 1 and 6.

2. The Combination of Kim, Kung, and Mäkelä et al. Does Not Teach or Suggest At Least One Element of Each of Claims 18 and 19

Claim 18 recites “a sensor configured to provide a configuration signal representative of the display being in one of the first configuration and the second configuration when the configuration is physically changed from the first configuration to the second configuration.” The cited combination of Kim in view of Kung and further in view of Mäkelä et al. does not teach, disclose, or suggest “a sensor configured to provide a configuration signal representative of the display being in one of the first configuration and the second

configuration when the configuration is physically changed from the first configuration to the second configuration" as included in the combination of elements of claim 18.

The Examiner has acknowledged that "Kim does not teach a sensor coupled to the processor such that the sensor is configured to provide a signal representative of the size of the display." However, the Examiner stated in response to Appellants' arguments filed December 21, 2004 that "Kung teaches positional sensors detecting changes in the orientation of the digital information appliance with respect to the surrounding environment," and maintained the assertion that "[o]ne would have been motivated in view of the suggestion in Kung that the sensing plate (102) is functionally equivalent to the desired sensor" because it "helps detect the expansion of the display screen as taught by Kung." Kung, however, discloses only that "[t]he touch screen comprises a display panel 104, a sensing plate 102, a display control 106, and a pressure detector 108," that "[t]he display panel 104 is used to display the image," and that "[t]he display control 106 controls the image as shown on the display panel 104, and zooms in on a portion of the image according to the position signal generated by the touch sensor." (See Column 2, lines 50-65). The sensing plate 102 is used to generate a position signal indicating a portion of the image to be expanded inside a variable display frame, and has nothing to do with the size of the display panel 104 itself. In contrast, the sensor of claim 18 is for sensing the expansion of an expandable display from a first size to a second size, rather than sensing a portion of displayed information, such as an image, to be expanded within a display.

Moreover, Appellants are describing and claiming the expandability of a physical object (i.e., a physical display) and not an image or variable display frame. Although the Examiner has suggested in response to Appellants' arguments of December 21, 2004 that Kim discloses physically resizing a display to a second size configuration, Appellants respectfully submit that the display of Kim has only one usable size, which is the display in the unfolded state, and thus cannot be physically "resized." Accordingly, Kim and Kung fail to disclose "a sensor configured to provide a configuration signal representative of the display being in one of the first configuration and the second configuration when the configuration is physically changed from the first configuration to the second configuration" as included in the combination of elements of claim 18.

Furthermore, Kung discloses only that “[t]he display control 106 controls the image shown on the display panel 104, and zooms in on a portion of the image according to the position signal generated by the touch sensor.” (See Column 2, lines 50-65). Thus, the sensing plate disclosed in Kung is configured to generate a position signal that initiates expansion of a portion of the image inside the variable display frame in response to user input, as opposed to being configured to generate an indication of the size of the display panel in response to a physical expansion in size of the display panel (or, for that matter, even being configured to generate an indication of the size of the image within the variable display frame in response to an expansion in size of the image or the variable display frame). Accordingly, Kim and Kung fail to disclose “a sensor configured to provide a configuration signal representative of the display being in one of the first configuration and the second configuration when the configuration is physically changed from the first configuration to the second configuration” as included in the combination of elements of claim 18.

As to Mäkelä et al., it also fails to disclose “a sensor configured to provide a configuration signal representative of the display being in one of the first configuration and the second configuration when the configuration is physically changed from the first configuration to the second configuration” as included in the combination of elements of claim 18. Thus, the combination of Kim, Kung, and Mäkelä et al. does not teach, disclose, or suggest “a sensor configured to provide a configuration signal representative of the display being in one of the first configuration and the second configuration when the configuration is physically changed from the first configuration to the second configuration,” and particularly not as part of a “display for an electronic device” when combined with the other elements of claim 18.

The rejection of claim 18 and claim 19 (which depends from claim 18) should be reversed because the combination of Kim, Kung, and Mäkelä et al. does not teach or suggest at least one element of each of claims 18 and 19.

III. REJECTION OF CLAIMS 7-8 AND 20 UNDER 35 U.S.C. § 103(a)

In the Office Action dated May 17, 2005, the Examiner rejected claims 7-8 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Kim in view of Kung and further in view of Mäkelä et al. and further in view of Macuka.

Claims 7-8 depend from claim 1.

Claim 20 depends from claim 18.

For the reasons stated below, Appellants submit that the Examiner's rejection of claims 7-8, and 20 is improper and should be reversed.

A. The Examiner's Rejection of Claims 7-8 and 20 Should Be Reversed Because There is No Suggestion to Combine the Teachings of Kim, Kung, Mäkelä et al., and Macuka

To establish a prima facie case of obviousness based on a combination of prior art references under 35 U.S.C. § 103(a), the Examiner must first show that there is a suggestion or motivation to combine the teachings of those references. This may come in the form of some objective teaching in the prior art or, alternatively, knowledge generally available to one of ordinary skill in the art at the time of the invention that would lead that individual to combine the relevant teachings of the references.

When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the Examiner to explain why the combination of teachings is proper. Ex parte Skinner, 2 U.S.P.Q.2d 1788 (Bd. Pat. App. & Inter. 1986). As described above, there is no suggestion or motivation to combine the teachings of Kim and Kung and Mäkelä et al.. For this reason, the rejection of claims 7-8 and 20 is improper and should be reversed.

B. The Examiner's Rejection of Claims 7-8 and 20 Should Be Reversed Because the Combination of Kim, Kung, Mäkelä et al., and Macuka Does Not Teach or Suggest At Least One Element of Each of Claims 7-8 and 20

To establish a prima facie case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). Even if Kim, Kung, Mäkelä et al., and Macuka could be

properly combined, these references do not teach or suggest at least one element of each of claims 7-8 and 20. Accordingly, the rejection of claims 7-8 and 20 under 35 U.S.C § 103(a) is improper and should be reversed.

1. The Combination of Kim, Kung, Mäkelä et al., and Macuka Does Not Teach or Suggest At Least One Element of Each of Claims 7-8

Claims 7-8 depend from claim 1. As described above, the combination of Kim, Kung, and Mäkelä et al. does not teach or suggest at least one element of claim 1. For example, claim 1 recites “a sensor coupled to the processor, the sensor configured to provide a signal representative of the size of the display,” which is not taught or suggested by the combination of Kim, Kung, and Mäkelä et al. Macuka also does not teach or suggest “a sensor coupled to the processor, the sensor configured to provide a signal representative of the size of the display” as recited in the combination of elements of claim 1. For this reason, the rejection of claims 7-8, which depend from claim 1, is improper and should be reversed.

Claims 7 and 8 also each additionally recite “wherein the expandable display includes a rollable display.” The cited combination of Kim, Kung, Mäkelä et al., and Macuka does not teach, disclose, or suggest “wherein the expandable display includes a rollable display” as included in the combination of elements of the “portable electronic device” as included in the combination elements of claim 7 or 8. For example, Macuka teaches a device for displaying paper goods, such as a rolled up map or blueprint that would never be coupled to a display controller or computing electronics for a portable electronic device. The remaining references in the cited combination clearly do not disclose the claimed rollable display for a portable electronic device. For this additional reason, the rejection of claims 7-8 is improper and should be reversed.

2. The Combination of Kim, Kung, Mäkelä et al., and Macuka Does Not Teach or Suggest At Least One Element of Claim 20

Claim 20 depends from claim 18. As described above, the combination of Kim, Kung, and Mäkelä et al. does not teach or suggest at least one element of claim 18. For example, claim 18 recites “a sensor configured to provide a configuration signal representative of the display being in one of the first configuration and the second configuration when the

configuration is physically changed from the first configuration to the second configuration,” which is not taught or suggested by the combination of Kim, Kung, and Mäkelä et al. Macuka also does not teach or suggest “a sensor configured to provide a configuration signal representative of the display being in one of the first configuration and the second configuration when the configuration is physically changed from the first configuration to the second configuration” as recited in the combination of elements of claim 18. For this reason, the rejection of claim 20, which depends from claim 18, is improper and should be reversed.

Claim 20 also recites “wherein the first and second display surfaces are part of a rollable display.” The cited combination of Kim, Kung, Mäkelä et al., and Macuka does not teach, disclose, or suggest “wherein the first and second display surfaces are part of a rollable display” as included in the combination of elements of claim 20. For example, Macuka teaches a device for displaying paper goods, such as a rolled up map or blueprint that would never be coupled to a display controller or computing electronics for a portable electronic device. The remaining references in the cited combination clearly do not disclose the claimed rollable display for a portable electronic device. For this additional reason, the rejection of claim 20 is improper and should be reversed.

IV. REJECTION OF CLAIMS 2-5, 14-17, AND 26-29 UNDER 35 U.S.C. § 103(a)

In the Office Action dated May 17, 2005, the Examiner rejected claims 2-5, 14-17, and 26-29 under 35 U.S.C. § 103(a) as being unpatentable over Kim in view of Kung and further in view of Mäkelä et al. and further in view of Kung et al.

Claims 2-5 depend from claim 1.

Claim 14 is in independent form and claims 13-17 depend from claim 14.

Claim 26 is in independent form and claims 27-29 depend from claim 26.

For the reasons stated below, Appellants submit that the Examiner’s rejection of claims 2-5, 14-17, and 26-29 is improper and should be reversed.

A. The Examiner's Rejection of Claims 2-5, 14-17, and 26-29 Should Be Reversed Because There is No Suggestion to Combine the Teachings of Kim, Kung, Mäkelä et al., and Kung et al.

To establish a *prima facie* case of obviousness based on a combination of prior art references under 35 U.S.C § 103(a), the Examiner must first show that there is a suggestion or motivation to combine the teachings of those references. This may come in the form of some objective teaching in the prior art or, alternatively, knowledge generally available to one of ordinary skill in the art at the time of the invention that would lead that individual to combine the relevant teachings of the references.

When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the Examiner to explain why the combination of teachings is proper. Ex parte Skinner, 2 U.S.P.Q.2d 1788 (Bd. Pat. App. & Inter. 1986). As described above, there is no suggestion or motivation to combine the teachings of Kim and Kung and Mäkelä et al.. For the same reasons, the rejection of claims 2-5, 14-17, and 26-29 is improper and should be reversed.

B. The Examiner's Rejection of Claims 2-5, 14-17, and 26-29 Should Be Reversed Because the Combination of Kim, Kung, Mäkelä et al., and Kung et al. Does Not Teach or Suggest At Least One Element of Each of Claims 2-5, 14-17, and 26-29

To establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). Even if Kim, Kung, Mäkelä et al., and Kung et al. could be properly combined, these references do not teach or suggest at least one element or step of each of claims 2-5, 14-17, and 26-29. Accordingly, the rejection of claims 2-5, 14-17, and 26-29 under 35 U.S.C § 103(a) is improper and should be reversed.

1. The Combination of Kim, Kung, Mäkelä et al., and Kung et al. Does Not Teach or Suggest At Least One Element of Each of Claims 2-5

Claims 2-5 depend from claim 1. As described above, the combination of Kim, Kung, and Mäkelä et al. does not teach or suggest at least one element of claim 1. For example, claim 1 recites “a sensor coupled to the processor, the sensor configured to provide a signal

representative of the size of the display,” which is not taught or suggested by the combination of Kim, Kung, and Mäkelä et al. Kung et al. also does not teach or suggest “a sensor coupled to the processor, the sensor configured to provide a signal representative of the size of the display” as recited in the combination of elements of claim 1. Thus, for at least this reason, the rejection of claims 2-5, which depend from claim 1, is improper and should be reversed.

2. The Combination of Kim, Kung, Mäkelä et al., and Kung et al. Does Not Teach or Suggest At Least One Element of Each of Claims 14-17

Claim 14 recites “physically resizing the display to a second size configuration” and “sensing, automatically, the second size configuration of the display.” The cited combination of Kim in view of Kung and further in view of Mäkelä et al. and further in view of Kung et al. does not teach, disclose, or suggest “physically resizing the display to a second size configuration” and “sensing, automatically, the second size configuration of the display” as recited in the combination of steps of claim 14.

The Examiner has stated that “regarding claim 14 ... Kim, Kung, and Makela have been discussed,” that “Kim does not teach a means of reformatting a displayed image, and that “Kung et al. show a display program (37) determining the contents of the display (34), which must be scrolled down and reformatted to display a new line of information (32). Thus, the Examiner has implied that the remaining steps of claim 14 are disclosed by the combination of Kim in view of Kung and further in view of Mäkelä et al..

However, Kim, Kung, and Mäkelä et al. do not teach, disclose, or suggest “physically resizing the display to a second size configuration” and “sensing, automatically, the second size configuration of the display” as recited in the combination of steps of claim 14. For example, Kung discloses only that “[t]he touch screen comprises a display panel 104, a sensing plate 102, a display control 106, and a pressure detector 108,” that “[t]he display panel 104 is used to display the image,” and that “[t]he display control 106 controls the image as shown on the display panel 104, and zooms in on a portion of the image according to the position signal generated by the touch sensor.” (See Column 2, lines 50-65). The sensing plate 102 is used to generate a position signal indicating a portion of the image to be expanded inside a variable display frame, and has nothing to do with the size of the display panel 104 itself. The sensing

plate disclosed in Kung is also configured to generate a position signal that initiates expansion of a portion of the image inside the variable display frame after a user provides input regarding a desired size of the image in the variable display frame, as opposed to being configured to automatically sense the size of the display panel in response to a physical expansion in size of the display panel. Accordingly, Kung fails to disclose “physically resizing the display to a second size configuration” and “sensing, automatically, the second size configuration of the display” as recited in the combination of steps of claim 14. As to Kim, Mäkelä et al. and Kung et al., they also fail to disclose “physically resizing the display to a second size configuration” and “sensing, automatically, the second size configuration of the display” as recited in the combination of steps of claim 14. Thus, the combination of Kim, Kung, Mäkelä et al., and Kung et al. does not teach, disclose, or suggest “physically resizing the display to a second size configuration” and “sensing, automatically, the second size configuration of the display,” and particularly not as part of a “method of providing information to a user of an electronic device” when combined with the other steps of claim 14.

The rejection of claim 14, and claims 15-17 (which depend from claim 14) should be reversed because the combination of Kim, Kung, and Mäkelä et al. does not teach or suggest at least one step of each of claims 14-17.

3. The Combination of Kim, Kung, Mäkelä et al., and Kung et al. Does Not Teach or Suggest At Least One Element of Each of Claims 26-29

Claim 26 recites “means for physically resizing the display to a second size configuration” and “means for sensing, automatically, the second size configuration of the display.” The cited combination of Kim in view of Kung and further in view of Mäkelä et al. and further in view of Kung et al. does not teach, disclose, or suggest “means for physically resizing the display to a second size configuration” and “means for sensing, automatically, the second size configuration of the display” as recited in the combination of elements of claim 26.

The Examiner has stated that “regarding claim 26 ... Kim, Kung, and Makela have been discussed,” that “Kim does not teach a means of reformatting a displayed image, and that “Kung et al. show a display program (37) determining the contents of the display (34), which must be

scrolled down and reformatted to display a new line of information (32). Thus, the Examiner has implied that the remaining elements of claim 26 are disclosed by the combination of Kim in view of Kung and further in view of Mäkelä et al.

However, Kim, Kung, and Mäkelä et al. do not teach, disclose, or suggest “means for physically resizing the display to a second size configuration” and “means for sensing, automatically, the second size configuration of the display” as recited in the combination of elements of claim 26. For example, Kung discloses only that “[t]he touch screen comprises a display panel 104, a sensing plate 102, a display control 106, and a pressure detector 108,” that “[t]he display panel 104 is used to display the image,” and that “[t]he display control 106 controls the image as shown on the display panel 104, and zooms in on a portion of the image according to the position signal generated by the touch sensor.” (See Column 2, lines 50-65). The sensing plate 102 is used to generate a position signal indicating a portion of the image to be expanded inside a variable display frame, and has nothing to do with the size of the display panel 104 itself. The sensing plate disclosed in Kung is also configured to generate a position signal that initiates expansion of a portion of the image inside the variable display frame after a user provides input regarding a desired size of the image in the variable display frame, as opposed to being configured to automatically sense the size of the display panel in response to a physical expansion in size of the display panel. Accordingly, Kung fails to disclose “means for physically resizing the display to a second size configuration” and “means for sensing, automatically, the second size configuration of the display” as recited in the combination of elements of claim 26. As to Kim, Mäkelä et al. and Kung et al., they also fail to disclose “means for physically resizing the display to a second size configuration” and “means for sensing, automatically, the second size configuration of the display” as recited in the combination of elements of claim 26. Thus, the combination of Kim, Kung, Mäkelä et al., and Kung et al. does not teach, disclose, or suggest “physically resizing the display to a second size configuration” and “sensing, automatically, the second size configuration of the display,” and particularly not as part of a “portable electronic device configured to provide information to a user of the portable electronic device” when combined with the other elements of claim 26.

The rejection of claim 26, and claims 27-29 (which depend from claim 26), should be reversed because the combination of Kim, Kung, and Mäkelä et al. does not teach or suggest at least one element of each of claims 26-29.

V. REJECTION OF CLAIMS 9-13, AND 21-25 UNDER 35 U.S.C. § 103(a)

In the Office Action dated May 17, 2005, the Examiner rejected claims 9-13 and 21-25 under 35 U.S.C. § 103(a) as being unpatentable over Kim in view of Kung and further in view of Mäkelä et al. and further in view of Petrich et al.

Claims 9-13 depend from claim 1.

Claims 21-25 depend from claim 18.

For the reasons stated below, Appellants submit that the Examiner's rejection of claims 9-13, and 21-25 is improper and should be reversed.

A. The Examiner's Rejection of Claims 9-13, and 21-25 Should Be Reversed Because There is No Suggestion to Combine the Teachings of Kim, Kung, Mäkelä et al., and Petrich et al.

To establish a prima facie case of obviousness based on a combination of prior art references under 35 U.S.C. § 103(a), the Examiner must first show that there is a suggestion or motivation to combine the teachings of those references. This may come in the form of some objective teaching in the prior art or, alternatively, knowledge generally available to one of ordinary skill in the art at the time of the invention that would lead that individual to combine the relevant teachings of the references.

When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the Examiner to explain why the combination of teachings is proper. Ex parte Skinner, 2 U.S.P.Q.2d 1788 (Bd. Pat. App. & Inter. 1986). As described above, there is no suggestion or motivation to combine the teachings of Kim and Kung and Mäkelä et al. For this reason, the rejection of claims 9-13 and 21-25 is improper and should be reversed.

B. The Examiner's Rejection of Claims 9-13 and 21-25 Should Be Reversed Because the Combination of Kim, Kung, Mäkelä et al., and Petrich et al. Does Not Teach or Suggest At Least One Element of Each of Claims 9-13 and 21-25

To establish a prima facie case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). Even if Kim, Kung, Mäkelä et al., and Kung et al. could be properly combined, these references do not teach or suggest at least one element or step of each of claims 9-13 and 21-25. Accordingly, the rejection of claims 9-13 and 21-25 under 35 U.S.C § 103(a) is improper and should be reversed.

1. The Combination of Kim, Kung, Mäkelä et al., and Petrich et al. Does Not Teach or Suggest At Least One Element of Each of Claims 9-13

Claims 9-13 depend from claim 1. As described above, the combination of Kim, Kung, and Mäkelä et al. does not teach or suggest at least one element of claim 1. For example, claim 1 recites “a sensor coupled to the processor, the sensor configured to provide a signal representative of the size of the display,” which is not taught or suggested by the combination of Kim, Kung, and Mäkelä et al. Petrich et al. also does not teach or suggest “a sensor coupled to the processor, the sensor configured to provide a signal representative of the size of the display” as recited in the combination of elements of claim 1. Thus, for at least this reason, the rejection of claims 9-13 (which depend from claim 1) is improper and should be reversed.

2. The Combination of Kim, Kung, Mäkelä et al., and Petrich et al. Does Not Teach or Suggest At Least One Element of Each of Claims 21-25

Claims 21-25 depend from claim 18. As described above, the combination of Kim, Kung, and Mäkelä et al. does not teach or suggest at least one element of claim 18. For example, claim 18 recites “a sensor configured to provide a configuration signal representative of the display being in one of the first configuration and the second configuration when the configuration is physically changed from the first configuration to the second configuration,” which is not taught or suggested by the combination of Kim, Kung, and Mäkelä et al. Macuka also does not teach or suggest “a sensor configured to provide a

configuration signal representative of the display being in one of the first configuration and the second configuration when the configuration is physically changed from the first configuration to the second configuration" as recited in the combination of elements of claim 18. For this reason, the rejection of claims 21-25 (which depend from claim 18) is improper and should be reversed.

8. CONCLUSION

In view of the foregoing, Appellants submit that claims 1, 6, and 18-19 are not properly rejected under 35 U.S.C § 103(a) over Kim in view of Kung and further in view of Mäkelä et al. and are therefore patentable. Appellants also submit that claims 7-8 and 20 are not properly rejected under 35 U.S.C § 103(a) over Kim in view of Kung and further in view of Mäkelä et al. and further in view of Macuka and are therefore patentable. Appellants further submit that claims 2-5, 14-17, and 26-29 are not properly rejected under 35 U.S.C § 103(a) over Kim in view of Kung and further in view of Mäkelä et al. and further in view of Petrich et al. and are therefore patentable. Accordingly, Appellants respectfully request that the Board reverse all claim rejections and indicate that a notice of allowance respecting all pending claims should be issued.

Respectfully submitted,

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CLAIMS APPENDIX

1. A portable electronic device, comprising:
 - a housing;
 - computing electronics supported by the housing, including a processor, a display controller coupled to the processor and memory coupled to the processor;
 - an expandable display coupled to the display controller, the expandable display is expandable from a first size to a second size, the first size being different than the second size, the display being viewable by a user in both the first size and second size configurations; and
 - a sensor coupled to the processor, the sensor configured to provide a signal representative of the size of the display.
2. The portable electronic device of claim 1, wherein the computing electronics run a program to interpret the signal and to reformat information on the display, to fill the display screen.
3. The portable electronic device of claim 2, wherein the reformat includes displaying more information on the display.
4. The portable electronic device of claim 2, wherein the reformat includes displaying less information on the display.
5. The portable electronic device of claim 2, wherein the reformat includes displaying the same amount of information at a different resolution.

6. The portable electronic device of claim 1, wherein the expandable display includes a foldable display.

7. The portable electronic device of claim 1, wherein the expandable display includes a rollable display.

8. The portable electronic device of claim 7, wherein the housing includes an aperture wherein a user may view information through the aperture on a portion of the rollable display within the housing

9. The portable electronic device of claim 1, wherein the sensor includes a hinge sensor.

10. The portable electronic device of claim 1, wherein the sensor includes an electrotextile sensor.

11. The portable electronic device of claim 1, wherein the sensor includes a magnetic sensor.

12. The portable electronic device of claim 1, wherein the sensor includes an electrical sensor.

13. The portable electronic device of claim 1, wherein the sensor includes an optical sensor.

14. A method of providing information to a user of an electronic device, comprising:

providing a first amount of user information on a display in a first size configuration;
physically resizing the display to a second size configuration;
sensing, automatically, the second size configuration of the display; and
reformatting the displayed image according to the second size configuration.

15. The method of claim 14 wherein the reformatting includes displaying a second amount of user information on the display in the second configuration.

16. The method of claim 15 wherein the second amount of user information is more than the first amount of user information.

17. The method of claim 15 wherein the first amount of user information is the same as the second amount of user information, and the second amount of user information is displayed at a different resolution.

18. A display for an electronic device, comprising:
a first display surface, the first display surface being visible in a first configuration;
a second display surface, the second display surface being larger than the first display surface, the second display surface being visible in a second configuration; and
a sensor configured to provide a configuration signal representative of the display being in one of the first configuration and the second configuration when the configuration is physically changed from the first configuration to the second configuration.

19. The display of claim 18 wherein the first and second display surfaces are part of a foldable display.

20. The display of claim 18 wherein the first and second display surfaces are part of a rollable display.

21. The display of claim 18 wherein the sensor includes a hinge sensor.

22. The display of claim 18 wherein the sensor includes an electrotextile sensor.

23. The display of claim 18 wherein the sensor includes a magnetic sensor.

24. The display of claim 18 wherein the sensor includes an electrical sensor.

25. The display of claim 18 wherein the sensor includes an optical sensor.

26. A portable electronic device configured to provide information to a user of the portable electronic device, comprising:

a means for providing a first amount of user information on a display in a first size configuration;

a means for physically resizing the display to a second size configuration;

a means for sensing, automatically, the second size configuration of the display; and

a means for reformatting the displayed image according to the second size configuration.

27. The portable electronic device of claim 26 wherein the means for reformatting includes a means displaying a second amount of user information on the display in the second configuration.

28. The portable electronic device of claim 27 wherein the second amount of user information is more than the first amount of user information.

29. The portable electronic device of claim 27 wherein the first amount of user information is the same as the second amount of user information, and the second amount of user information is displayed at a different resolution.

EVIDENCE APPENDIX

None

RELATED PROCEEDINGS APPENDIX

None